

Remarks

Double Patenting

The Office Action has rejected claims 1-6 under the judicially created doctrine of obviousness-type double patenting over claims 1-3 of U.S. Patent No. 6,618,698. Applicant submits herewith a terminal disclaimer in compliance with 37 CFR 1.321(c) to obviate this rejection.

Rejections Under 35 U.S.C. § 103

The Office Action has rejected claims 1-6 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 6,618,698 ("the '698 patent") in view of Official Notice. Applicant respectfully traverses this rejection. The '698 patent was filed on August 12, 1999 and issued on September 9, 2003. The present application was filed on September 6, 2000. Thus, the '698 patent is a prior art under § 102(e). As will be demonstrated below, the inventors of the claimed subject matter for both the '698 patent and the present application had an obligation to assign their inventions to the same assignee. Therefore, Applicant respectfully submits that § 103(a) is inapplicable to this application and that § 103(c) controls. Because of this, Applicant respectfully requests that this rejection be withdrawn.

Evidence Required To Establish Common Ownership (MPEP 706.02(l)(2)II)

It is hereby stated by the undersigned, the attorney of record for the Applicant, that Application Serial No. 09/656,541 and Application Serial No. 09/373,125, from which the '698 patent issued, were, at the time the invention disclosed in Application 09/656,541 was made, commonly owned by, or commonly subject to an obligation of assignment to, International

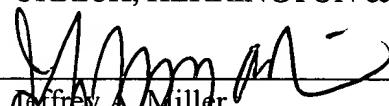
Business Machines Corporation of Armonk, New York, U.S.A. A copy of the Recordation Form Cover Sheet and the Notice of Patent Assignment reflecting the above-described common ownership is enclosed for the Examiner's review. The assignment documents for the '698 patent (Application 09/373,125) can be found at Exhibit A. The assignment documents for the present application (Application Serial No. 09/656,541) can be found at Exhibit B. The Applicant therefore respectfully submits that U.S. Patent 6,618,698 does not preclude, under 35 U.S.C. § 103(a), the patentability of the subject Application 09/656,541.

Based on the foregoing, Applicant respectfully submits that the subject application is in condition for allowance. The Applicant therefore respectfully requests that the subject application be allowed.

Should the Examiner have any questions or comments on the application, the undersigned can be reached at (650) 614-7660.

Respectfully submitted,  
ORRICK, HERRINGTON & SUTCLIFFE LLP

Dated: March 17, 2004 By: \_\_\_\_\_

  
Jeffrey A. Miller  
Reg. No. 35,287

Four Park Plaza, Suite 1600  
Irvine, California 92614-2558  
(650) 614-7660